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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,702	01/28/2004	Longin B. Greszczuk	BOE-002A	3817

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EXAMINER

BRUNSMAN, DAVID M

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,702

Applicant(s)

GRESZCZUK, LONGIN B.

Examiner

David M. Brunsman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20040128.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no antecedent basis for "the polymeric mixture".

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 8-17, 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 1333057.

The reference teaches a composition for sealing porous floors that can be applied by a brush (page 2, line 12) comprising 60 parts paraffin wax (C_{25-30} paraffins, having a melting point of about 120-160 F), 15 parts beeswax (fatty acid esters, having a melting point of about 149 F), 15 parts carnauba wax (fatty acid esters, having a melting point of about 187 F) and, 12 parts coloring matter such as chromium oxide. See page 1, lines 70-75. No bubbles are disclosed in the finished mixture. The reference does not disclose the melting point of the waxes mixed of the melting point of the entire mixture. The rule of mixtures predicts that the melting point of the mixture would be about $(.6(160)+.15(149)+.15(187))/0.9=163$ F. In combination with the application temperature of the mixture of 212 F (page 2, line 8), it is considered that the melting point of the mixture would fall within the range of *about* 170-190 F. No criticality for compositions exactly falling within the narrow range of 170-190 F is demonstrated in the instant application. The description of the composition coating and sealing to a depth of 1/2 inch with the clearly hydrophobic waxes indicates a reduction in moisture absorption. The reference does not explicitly recite the degree of reduction. However, the similar

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ingredients employed and manner of use would be expected to exhibit similar physical properties.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-7, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 1333057, as applied above, in view of US Patent 5106415.

The difference between US 1333057 and the instant claims is the recitation of the dispersed powder as aluminum metal (comprising particulates of the size 25-60 microns) or titanium dioxide. US 5106415 teaches a formulation for a wax-based protective coating comprising a powder component of a filler such as 25-150 micron aluminum powder and/or a pigment such as titanium dioxide. (See column 3, lines 3-10, 37-38). It would have been obvious to one of ordinary skill in the art to substitute the aluminum powder or titanium dioxide of US 5106415 for the chromium oxide of 1333057 because the secondary reference teaches they are useful in similar wax-based applications.

Claims 1-20 of this application conflict with claims 1-21 of Application No. 10/766702. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting

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claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-7, 9 and 12-14 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-7, 9 and 11-13, respectively, of copending Application No. 10816384. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The instant claims above differ from the prior art only in the recited intended use and the intrinsic physical property of reduced moisture loss in the intended use. While this property may be best measured during the intended use, the similar compositions employed by the other application would be expected to possess the same physical properties. There is no evidence of record that the compositions claimed in either application are materially limited by the recitation of intended use.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

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ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7, 9 and 12-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 9 and 11-13, respectively, of copending Application No. 10/816384. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in the recited use. One of ordinary skill in this art understanding the basic chemical and engineering principles of the art and would recognize that a composition designed to seal a porous surface and prevent water absorption thereby would prevent water transport at either interface likewise preventing water loss from a moist substrate. See, *ex Parte Hiyamizu*, 10 USPQ2d 1393.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 8, 10 and 15-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8, 10 and 14-20, respectively, of copending Application No. 10/766702. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 8 differs in the range of the melting point of the wax/paraffin mixture. The ranges overlap between 120 F and 200 F. Without a showing of criticality or unexpected results for the difference in the ranges, product claims having overlapping numerical ranges would have been obvious to one of ordinary skill in the art. *In re Malagari*, 182 USPQ 549.

Claims 14-20 of the instant application differ from claims 15-21 of the 10/766702 application in the range at which the mixture of fatty acid esters and hydrocarbons melt/soften. The ranges overlap between 180 F and 190 F. Without a showing of criticality

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or unexpected results for the difference in the ranges, product claims having overlapping numerical ranges would have been obvious to one of ordinary skill in the art. *In re Malagari*, 182 USPQ 549.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 11 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of copending Application No. 10/766702. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 11 depend upon claim 10 which is obvious over claim 10 of the 10/816384 application, as explained above, yet further differs in that it recites the composition wherein the physical properties enable application by spraying or painting with a brush or roller. The similar compositions employed by the other application would be expected to possess the same physical properties, anticipating the limitation of claim 11.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Brunsman whose telephone number is 571-272-1365. The examiner can normally be reached on M, W, F, Sa; 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David M Brunzman
Primary Examiner
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A handwritten signature in black ink, appearing to read 'David M Brunzman', with a long horizontal flourish extending to the right.

DMB